APR 9 2001

No. 00-1346

FILED

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IN THE

Supreme Court of the United States

MOORE NORTH AMERICA, INC. (FORMERLY KNOWN AS MOORE U.S.A., INC.),

Petitioner,

vs.

STANDARD REGISTER COMPANY,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

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LIST OF PARTIES AND CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rules 14.1(b) and 29.6, counsel for the Petitioner, MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., hereby certifies the following:

1. The full names of every party to the proceeding sought to be reviewed are: MOORE NORTH AMERICA, INC., formerly known as MOORE U.S.A., INC., and the STANDARD REGISTER COMPANY.

2. Petitioner's parent corporation is MOORE CORPORATION, LTD., whose stock is publicly traded on the New York Stock Exchange.

3. To the best of Petitioner's information and belief, Respondent's stock is traded on the New York Stock Exchange, and there is no publicly held company that owns 10% or more of its stock.

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REPLY TO BRIEF IN OPPOSITION

Petitioner Moore North America, Inc. ("Moore"), submits this Reply to the Brief In Opposition filed by Respondent The Standard Register Company ("SRC").

ARGUMENT

SRC attempts to divert the Court's attention from the significant, equivalency-narrowing, precedent created by the decision below by arguing that it was merely "fact-specific" and presents no "compelling reasons" to grant *certiorari*. To do so, SRC not only misstates the record below, but ignores the Federal Circuit's own citation of this case in subsequent decisions and the critical commentary this case has already generated in the patent bar.

Recognizing SRC's attempt to bait Moore into a "fact-specific" reply, Moore will only address SRC's misstatements in context and focus on the significance of the legal questions presented. In addition to *DeMarini Sports, Inc. v. Worth, Inc.*, Nos. 99-1561, 99-1583, 2001 U.S. App. LEXIS 2093 (Fed. Cir. 2001), discussed at pages 4 and 12 of Moore's Petition, the Federal Circuit has since relied upon the decision below to bar application of the doctrine of equivalents, as a matter of law, by "implied" exclusions in patent claims. *See Scimed Life Systems, Inc.* v. *Advanced Cardiovascular Systems, Inc.*, No. 99-1499, 2001 U.S. App. LEXIS 3864 (Fed. Cir. Mar.14, 2001) (Reply App. A at 1a). These decisions, addressing Moore's Questions 1-3 on facts distinct from this case, directly refute SRC's contentions.

Moreover, the September 29, 2000 issue of the *Patent, Trademark & Copyright Journal* declares (focusing primarily on Question 4) that the decision under review "provides another occasion for lawyers to complain about conflicting Federal Circuit case law." Reply App. E at 54a. That comment was followed by a January 2001 article, citing the decision below (primarily Question 3), as further indicia

of "the Federal Circuit['s] whittling away at the ... doctrine [of equivalents]." Steven E. Koffs, *What's Left of The Doctrine of Equivalents?*, The Legal Intelligencer, Jan. 4, 2001, at 5 (Reply App. C at 38a). The instant decision is also cited (again regarding Question 3) by the Patent Resources Group in its seminar on "Federal Circuit Advanced Patent Law" as one of the five most "surprising and diverse" examples of "[t]he Federal Circuit's various panels' lack of coherent doctrinal stability." Reply App. D at 44a-45a. Finally, the decision below was the featured case in a recent article relating to Question 3, authored by Corwin P. Umbach, Ph.D., a colleague of SRC's own counsel at Oblon, Spivak, McClelland, Maier & Neustadt. In *Narrow Claiming and The Scope of Equivalents: I Meant What I Said And I Said What I Meant...*", Intell. Prop. Today, March 2001, Dr. Umbach describes the decision below as the "culminati[on]" of recent decisions "show[ing] that the Federal Circuit is willing to find legal limits on the scope of equivalents based solely on [a judicial assessment of] the narrowness of claim limitations." Reply App. B at 31a. Moreover, according to Dr. Umbach, the best that even Ph.D. patent practitioners can take from the decision below is the illogical conclusion that "substitution of 'greater than 50%' [*i.e.*, the literal definition of 'majority'] for the 'majority' limitation in *Moore* would have avoided the sharply restricted scope of equivalents." Reply App. B, at 32a. This commentary was not acknowledged in SRC's Opposition.[1]

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[1] SRC's curious Question 2, asserting that one issue presented by Moore for review was so "unimportant . . . [that Moore] devoted exactly one conclusory sentence to it in its appeal brief below," Opp. at i, is mystifying. If this statement refers to Moore's Question 5, *i.e.*, Moore's Fed. R. Civ. P. 56 argument, *see* Opp. at 15, SRC's own factual support, a *partial* reprint of Moore's opening brief below, Opp. App. B, itself shows three pages of single-spaced argument regarding the violation of Rule 56. If, however, SRC's Question 2 is intended to refer to equivalency under the '798 patent, Opp. at 7, Moore's Petition presents no such issue for review.

I. The Court Should Grant *Certiorari* of Moore's First Question Presented.

The Federal Circuit cited, but refused to follow, this Court's precedent requiring a functional analysis under the doctrine of equivalents. SRC attempts to justify the Federal Circuit's error in two unavailing ways.

First, SRC contends (without supporting citation) that the lower court actually performed a functional analysis with respect to U.S. Patent No. 5,201,464 ("the '464 patent").[2] The record shows that the Federal Circuit, driven solely by its literal interpretation of disputed claim terms, failed to apply the doctrine of equivalents to the '464 patent at all, let alone perform a functional analysis. *See* Pet. App. at 24a-33a. Moore's First Question is clearly not "hypothetical."

Second, like the Federal Circuit, SRC incorrectly concludes that the All-Elements Rule can foreclose a functional equivalency analysis. The logical fallacy in this argument is that every equivalency case involves a "missing" claim limitation. *See, e.g., Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564-65 (Fed. Cir. 1989) ("The essence of the doctrine of equivalents is that it permits recovery for infringement where the accused device does *not* fall within the literal scope of the claims and is, therefore, outside their literal scope."); *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, 1317 (Fed. Cir. 1998). Accordingly, the determination of whether an accused product comports with the All-Elements Rule must be made *after*, not before, a functional analysis of the "role" played by the missing element.

Where the accused product does not infringe literally, the factfinder must first determine the role of the "missing" element in order to determine whether a counterpart element

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[2] Moore's equivalency argument is limited to the '464 patent.

is present in the accused product. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 40 (1997).[3] If a counterpart element for that role is present, the factfinder must then determine whether the accused element is "insubstantially different" from the claimed element, if it is a "known interchangeable" of the claimed element, or if it performs "substantially the same function in substantially the same way to achieve substantially the same result as the claimed element." *Id.* If the accused product also contains all other claim elements, either literally or by equivalents, the All-Elements Rule is satisfied.

The Federal Circuit and SRC nevertheless insist that the equivalency analysis begin and end with the All-Elements Rule. However, that approach restricts the doctrine of equivalents to cases in which the accused product already meets each claimed limitation *literally*. As such, the Federal Circuit's approach reduces the doctrine of equivalents to a useless and redundant literal analysis that completely eviscerates this Court's holding in *Warner-Jenkinson Co.*

II. The Court Should Grant *Certiorari* of Moore's Second Question Presented.

The district court expressly relied upon the Federal Circuit's more recent decision in *Sage Products, Inc. v. Devon Industries., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), as controlling authority over this Court's decision in *Sanitary*

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[3] *See also Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989) ("An equivalent must be found for every limitation of the claim *somewhere* in an accused device, *but not necessarily in a corresponding component*, although that is generally the case.") (emphasis added); *Ethicon*, 149 F.3d at 1320 ("[o]ne-to-one correspondence of components is not required, and elements or steps may be combined without ipso facto loss of equivalency") (citations omitted).

Refrigerator v. Winters, 280 U.S. 30 (1929).[4] The Federal Circuit affirmed that error by sidestepping *Sanitary Refrigerator* based on the All-Elements Rule.[5] By doing so, it has now elevated that error into a broad new rule of law.

Because SRC does not dispute that its accused forms have elements that are known to be interchangeable with the elements of claim 9 of the '464 patent, or that its accused elements perform substantially the same function in substantially the same way to achieve substantially the same result as the claimed elements, controlling Supreme Court law – notably, *Sanitary Refrigerator* – would require a finding of infringement under the doctrine of equivalents. However, the Federal Circuit looked to its own case law, *i.e.*, *Sage*, and held otherwise.[6] That holding flies in the face of this Court's precedent and threatens to destroy the entire purpose of the doctrine, namely to "temper unsparing logic and prevent an infringer from stealing the benefit of the invention." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (quoting *Sanitary Refrigerator*, 280 U.S. at 42).

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[4] Pet. App. at 65a ("Although plaintiff points to a 1929 Supreme Court opinion [*Sanitary Refrigerator*] that has to some extent condoned the rearrangement of elements in a patent claim, the Federal Circuit's language [in *Sage*] is unequivocal in rejecting such rearrangement, and this court at this stage is bound by the Federal Circuit's clear language.").

[5] SRC's assertion that the Federal Circuit "expressly adopted Moore's arguments concerning *Sanitary Refrigerator* . . .," Opp. at 4, ignores that court's express holding that, "contrary to Moore's belief," "*Sanitary Refrigerator* cannot properly be viewed as a case sanctioning the rearrangement of claim limitations." Pet. App. at 32a.

[6] To rationalize the Federal Circuit's holding, SRC cites the reference in *Sanitary Refrigerator* regarding "the essence of the invention." Opp. at 8-9. However, nothing in that decision suggests that the mere recitation of structure in a patent claim transforms that structure into "the essence of the invention."

III. The Court Should Grant *Certiorari* of Moore's Third Question Presented.

The Federal Circuit's ruling as a matter of law that, regardless of function, claim 1 of the '464 patent could never cover a business form with adhesive strips extending less than a "majority" of the form length evidences a clear disregard for this Court's mandate in *Warner-Jenkinson* that function, not semantics, controls the analysis. SRC argues, without citation, that the Federal Circuit "implicitly accepted" that the claimed and accused adhesive strips perform the same function. Opp. at 10. The truth is that the Federal Circuit looked no farther than what it considered to be the "inherent narrowness" of the term "majority" and refused *as a matter of law* to even consider the function of the claimed strips. Pet. App. at 26a-27a.[7] The Federal Circuit's use of its newly created but unexplained "inherent narrowness" doctrine reduces the doctrine of equivalents to an arbitrary, linguistic analysis, effectively eliminates equivalency as a viable infringement theory, and undermines this Court's long-standing endorsement of the doctrine of equivalents.

Moreover, the Federal Circuit's ruling is not limited to this case. In addition to the court's citation to the ruling below in *DeMarini Sports, Inc.*, 2001 U.S. App. LEXIS 2093, with respect to rearranged claim elements, it also relied upon this case to limit patent claims to the preferred embodiment disclosed in the specification, despite broad *literal* claim language covering the accused product in *Scimed Life Systems, Inc.*, 2001 U.S. App. LEXIS 3864, at

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[7] Despite SRC's suggestion, Opp. at 3-4, the Federal Circuit explicitly stated that its decision of non-infringement of claim 1 of the '464 patent was not based upon element [e] of that claim. Pet. App. A at 28a n.1. Moreover, the panel's dicta regarding that element suffers from the same failure to consider function that permeates the court's actual holding with respect to the '464 patent. *See* Pet. at 13 n.11.

** 23-24 (Reply App. A at 14a-15a). Furthermore, at least three commentators have already written on the impact of the decision. *See* Reply Apps. B, C, E (discussed *supra*). A recent patent bar seminar even cited the decision below as illustrating "[t]he Federal Circuit's various panels' lack of coherent doctrinal stability." Reply App. D at 44a-45a. These citations demonstrate the compelling need for review of the broad new rules established by the decision below.

IV. The Court Should Grant *Certiorari* of Moore's Fourth Question Presented.

The Federal Circuit's "dedication estoppel" theory also threatens to destroy the doctrine of equivalents as defined by this Court in its landmark *Graver Tank* decision. Even though the Federal Circuit has acknowledged the conflict between its "dedication estoppel" theory and the law of this Court, *see YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320-21 (Fed. Cir. 1998), the lower court continues to use that theory to restrict the doctrine of equivalents to the literal claim language.

SRC's portrayal of this new limitation on the doctrine of equivalents as established precedent is not compelling. For example, in *Environmental Instruments, Inc.*, 877 F.2d at 1564-66, the Federal Circuit limited its "dedication" theory to the asserted claim's *literal* scope and actually found no infringement under the doctrine of equivalents as a result of prosecution history estoppel. More significantly, this Court long ago rejected the dedication approach of *Miller v. Bridgeport Brass Co.*, 104 U.S. 350 (1881), as a limitation on the doctrine of equivalents in *Graver Tank*, 339 U.S. at 612, 614-15.[8]

If this Court nevertheless agrees with SRC that *Miller* sanctions the exclusion of disclosed but unclaimed

[8] Nor does the dicta in *Graham v. John Deere Co.*, 384 U.S. 1, 31 n.17 (1966), regarding patent *validity* add anything to the equivalency issue.

embodiments from the scope of equivalence, then a clear conflict exists not only in Federal Circuit precedent,[9] but in this Court's precedent, as well.[10] Accordingly, the Court's clear guidance regarding dedication estoppel is not only necessary in this case, but urgently needed by the Federal Circuit for its upcoming *en banc* review of that theory in *Johnson & Johnston Associates, Inc. v. R.E. Service Co., Inc.* (Nos. 99-1076, -1179, -1180).

SRC also completely fails to address the larger policy problems that the Federal Circuit's dedication estoppel theory creates. For example, dedication estoppel discourages full disclosure in patent specifications and chills patentees' rights to file continuation applications, which rely on material that was disclosed but not claimed in a predecessor patent application. In addition, 35 U.S.C. § 112 requires a patentee to provide sufficient detail to enable those of ordinary skill in the art to practice the claimed invention. Yet, under the Federal Circuit's dedication estoppel, patentees will be punished for providing any disclosure that may not be literally covered by the claims. Thus, patentees will opt to provide only the most limited "bare bones" disclosures to avoid the draconian impact of the Federal Circuit's "dedication estoppel" rule of law. That result cannot be consistent with the policy underlying Section 112 or the basic purpose of the patent system to "promote the Progress of Science and useful Arts"[11] by disclosing all embodiments of an invention known at the time the application is filed.

"Dedication estoppel" further conflicts with the basic premise of the doctrine of equivalents: to provide a fair and equitable scope to an invention that necessarily goes beyond

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[9] *Compare YBM Magnex, Inc. v.*, 145 F.3d at 1320-22, *with Maxwell v. J. Baker*, 86 F.3d 1098 (Fed. Cir. 1996).

[10] *Compare Graver Tank*, 339 U.S. at 612-18.

[11] U.S. Const., art. I, § 8, cl. 8.

the strict, literal language of the claims, but is consistent with the patent's teaching as a whole.

This Court charged the Federal Circuit with the task of filling in the details of the doctrine of equivalents. *See Warner-Jenkinson*, 520 U.S. at 40. However, the Federal Circuit's response has been to take every opportunity to limit the doctrine of equivalents to the literal scope of the patent claims. The Court must take this opportunity to reaffirm at least one immutable rule: In the absence of prosecution history estoppel or limiting prior art, the factfinder must compare the *functions* of the claimed and accused elements.

V. The Court Should Grant *Certiorari* of Moore's Fifth Question Presented

SRC attempts to mislead the Court with respect to Moore's non-receipt of documents relevant to the summary judgment on U.S. Patent No. 5,253,798 ("the *'798* patent"). SRC states: "What Moore fails to tell the Court is that it specifically asked SRC to **not** supply it with those documents as a cost-saving measure . . . before the district court granted summary judgment on the *'464* patent on April 17, 1998." Opp. at 2 n.2 (bold in original, italics added). SRC's factual cite further reveals its sleight of hand, *i.e.*, Moore's *March 25, 1998* letter, Opp. App. A at 1a-3a, was written 5 days *after* the district had granted summary judgment on the *'798* patent on *March 20, 1998*! Pet. at 4-8, 24; Pet. App. E at 70a-79a; Pet. App. L at 98a. Space does not permit a rebuttal of SRC's various other factual misstatements, but the Court's attention is drawn to the telling lack of citations for virtually all of SRC's allegedly "factual" assertions. *See, e.g.*, Opp. at 13 n.16.

SRC's argument that procedural decisions in patent cases should be immune from review simply because the court below applies the law of various regional circuits, Opp. at 13-14 & n.17, is untenable in view of *Exxon Corp. v. United States*, 931 F.2d 874, 877 n.4 (1991), and the due process

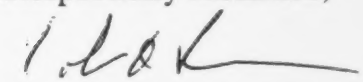
considerations inherent in Fed. R. Civ. P. 56(f), which cannot be made to turn on the subject matter of the suit in question.

CONCLUSION

Despite SRC's best efforts to change the fundamental nature of the dispute as to the '464 patent, that dispute is not fact-intensive. Rather, this case, which never moved beyond summary judgment, is about the lower court's distortion of controlling Supreme Court precedent. Distilled to its essence, the dispute is whether the Federal Circuit is free to disregard this Court's clear instructions by resolving equivalency issues in a discretionary manner without undertaking the functional analysis required by this Court. The Federal Circuit's repeated citation to *Warner-Jenkinson* does nothing to remedy the fact that the court below plainly rejected this Court's earlier instruction and again chose to set its own course on the doctrine of equivalents.

While the Rule 56(f) issue involving the '798 patent is slightly more fact-intensive, those facts are fully documented by record citations in Moore's Petition and are not meaningfully contravened by the unsupported and explicitly misleading assertions in SRC's Opposition. Moreover, the Rule 56(f) decisions below present issues of law as compelling as any addressed in this Court's 1986 summary judgment trilogy.

Respectfully submitted,



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APPENDIX

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

99-1499

SCIMED LIFE SYSTEMS, INC.,
Plaintiff-Appellant,
v.
ADVANCED CARDIOVASCULAR SYSTEMS, INC.,
Defendant-Appellee.

DECIDED: March 14, 2001

Appealed from: United States District Court for the Northern District of California
Judge Martin J. Jenkins

Before BRYSON, *Circuit Judge*, PLAGER, *Senior Circuit Judge*, and DYK, *Circuit Judge*.

Opinion for the court filed by *Circuit Judge* BRYSON. Concurring opinion filed by *Circuit Judge* DYK.

BRYSON, *Circuit Judge*.

SciMed Life Systems, Inc., (SciMed) owns three U.S. patents drawn to features of balloon dilatation catheters: U.S. Patent Nos. 5,156,594 (the '594 patent), 5,217,482 (the '482 patent), and 5,395,334 (the '334 patent). SciMed filed suit against Advanced Cardiovascular Systems, Inc., (ACS)

in the United States District Court for the Northern District of California, charging ACS with infringement of each of the three patents. On ACS's motion for summary judgment, the district court ruled that ACS had not infringed the disputed patents. The district court's ruling was based on the court's conclusion that the asserted claims were limited to a structure not found in ACS's accused devices and on the court's conclusion that ACS's devices did not infringe SciMed's patents under the doctrine of equivalents. We agree with the district court's claim construction and its ruling on the equivalents issue. We therefore affirm the summary judgment of non-infringement.

I

Balloon dilatation catheters are used in coronary angioplasty procedures to remove restrictions in coronary arteries. The SciMed patents describe catheters having three sections: a first shaft section, a second shaft section, and a transition section between the two. The first shaft section is long, relatively stiff, and generally tubular. The second shaft section is relatively flexible and contains a balloon at the end, which is inflated to relieve the arterial restriction. The transition section connects the first and second shaft sections and provides a gradual transition in stiffness between the two shaft sections.

The catheters claimed in the SciMed patents contain two passageways, or lumens. The first lumen, the guide-wire lumen, is used to guide the catheter through a patient's arteries to the site of the arterial restriction. A guide wire is first inserted into one of the patient's arteries. The guide-wire lumen is then threaded over the guide wire to guide the catheter through the patient's arteries until the catheter reaches the coronary restriction. In the invention recited in the SciMed patents, the guide wire does not enter the catheter at the proximal end of the catheter, i.e., the end closer to the surgeon, but at a point nearer to the distal end of

the catheter, i.e., the leading end of the catheter as it is inserted into the patient. The guide-wire lumen is present only in the distal portion of the catheter and does not extend the entire length of the catheter. The second lumen is the inflation lumen. It extends through all sections of the catheter and terminates in a connection with the balloon. The balloon is inflated by forcing fluid into the inflation lumen. The balloon then compresses the material restricting the artery, thereby relieving the restriction.

The parties agree that only two arrangements of the two lumens are known and practiced in the art. In the dual (or adjacent) lumen configuration, the two lumens are positioned side-by-side within the catheter. In the coaxial lumen configuration, the guide wire lumen runs inside the inflation lumen; in that configuration the inflation lumen, viewed in cross-section, is annular in shape. The parties also agree that the accused ACS devices employ only the dual lumen configuration and that the preferred embodiment described in the SciMed patents employs the coaxial lumen configuration.

Based on language in the common written description portion of the three SciMed patents, the district court construed the asserted claims of the patents to be limited to catheters with coaxial lumens, and not to read on catheters with a dual lumen configuration. The court noted that "the language contained in SciMed's specifications expressly limits all embodiments of the claimed invention to a coaxial structure." The court focused in particular on language from the common specification describing the coaxial lumen structure as the "basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein." That language, the court concluded, "leaves no doubt that a person skilled in the art would conclude that the inventor envisioned only one design for the catheters taught in SciMed's patents--an intermediate sleeve section containing two . . . lumens arranged coaxially."

In light of the district court's construction of the asserted claims, SciMed conceded that ACS's accused catheters did not literally infringe any of the asserted claims. In addition, the court held on summary judgment that the two lumen arrangements were sufficiently different that no reasonable jury could find the accused catheters to infringe the SciMed patents under the doctrine of equivalents. SciMed appeals the claim construction and the summary judgment based on that construction.

II

The principal question in this case is a narrow one: whether the common specification of the three patents limits the scope of the asserted claims to catheters with coaxial lumens. There is nothing pertinent to this issue in the prosecution history of the three patents; the case turns entirely on an interpretation of the asserted claims in light of the specification, which is essentially identical for each of the three patents. Like the district court, we interpret the specification to disclaim the dual lumen configuration and to limit the scope of the asserted claims to catheters with coaxial lumen structures having annular inflation lumens. We therefore construe the asserted claims to read only on catheters with coaxial lumens, and not on catheters with dual or side-by-side lumens.

Claim 19 of the '594 patent is representative of the asserted claims of the three patents in suit. It claims the following:

> In an elongate dilatation catheter of the type that can be slidably moved along a guide wire that can extend past a distal end of the catheter, wherein the guide wire is received in a guide wire lumen of the catheter, the guide wire extending from a distal guide wire lumen opening to a proximal guide wire lumen opening disposed in a portion of the catheter that is spaced distally from a proximal end of the

> catheter, the dilatation catheter including an inflatable balloon and an inflation lumen extending through the catheter separate from the guide wire lumen, an improvement comprising:
>
> a first proximal shaft section of the catheter defined by a relatively rigid metallic tube;
>
> a second shaft section disposed distally of the first shaft section, the second shaft section being relatively more flexible than the first shaft section; and
>
> a transition section disposed between the first shaft section and the second shaft section, the transition section including a transition member comprising a metallic element of gradually diminished dimension, the transition member extending adjacent to the proximal guide wire lumen opening, and the transition member having gradually decreasing rigidity in the distal direction to provide a relatively smooth transition between the first shaft section and the second shaft section.

SciMed argues at length that in construing the claims based on the written description, the district court has committed one of the cardinal sins of patent law--reading a limitation from the written description into the claims. *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). But that is not an accurate characterization of what the district court did. Instead, the district court properly followed the invocation that "[c]laims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments*, 52 F.3d 967, 979-980, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996); *see also United States v. Adams*, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966) ("[C]laims are to be construed in light of the specifications and both are to be read with a view to

ascertaining the invention."); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) ("Claims are not interpreted in a vacuum, but are part of and are read in light of the specification.").

As this court has recently explained, "[o]ne purpose for examining the specification is to determine if the patentee has limited the scope of the claims." *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882, 56 USPQ2d 1836, 1839 (Fed. Cir. 2000). Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. Thus, in the *Watts* case, the claim in dispute recited pipe joints that could be "sealingly connected." The court noted that the specification described only one method to achieve the sealing connection, that is, to misalign the taper angles of the respective threads of the joined pipes. The court pointed out that the specification "actually limits the invention to structures that utilize misaligned taper angles, stating that 'the present invention utilizes [the varying taper angle] feature.'" 232 F.3d at 883, 56 USPQ2d at 1840. In light of that statement, the court construed the claim language as limited to connections effected by misaligned taper angles.

Another case in which the claims were given a narrow construction in light of the written description is *Wang Labs, Inc. v. America Online, Inc.*, 197 F.3d 1377, 53 USPQ2d 1161 (Fed. Cir. 1999). In that case, the parties agreed that in general usage the claim term "frame" could be applied both to "bit-mapped display systems" and to "character-based systems." The court, however, construed the claims as limited to character-based systems. The court noted that the "only system that is described and enabled" in the patent specification "uses a character-based protocol," and that

references to bit-mapped protocols did "not describe them as included in the applicant's invention, and that the specification would not be so understood by a person skilled in the field of the invention." *Id.* at 1382, 53 USPQ2d at 1164. Citing *Modine Manufacturing Co. v. United States International Trade Commission*, 75 F.3d 1545, 1551, 37 USPQ2d 1609, 1612 (Fed. Cir. 1996), the court explained that "when the 'preferred embodiment' is described as the invention itself, the claims are not entitled to a broader scope than that embodiment." 197 F.3d at 1383, 53 USPQ2d at 1165.

The court in *Cultor Corp. v. A.E. Staley Manufacturing Co.*, 224 F.3d 1328, 56 USPQ2d 1208 (Fed. Cir. 2000), followed a similar analytical path. Although the claim language referred broadly to dissolving polydextrose in water, the written description made clear that the water-soluble polydextrose referred to in the claims was polydextrose prepared using a citric acid catalyst. Because the written description explicitly limited the subject matter of the patent to a polydextrose purification process using a citric acid catalyst, the court declined to hold that the asserted claims read on a process using a catalyst other than citric acid, even though the claims themselves did not refer to citric acid. The explicit reference in the specification to the invention as a process limited to one prepared with the citric acid catalyst, the court held, "effected a disclaimer of the other prior art acids. Claims are not correctly construed to cover what was expressly disclaimed." 224 F.3d at 1331, 56 USPQ2d at 1210.

In another similar case, *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581, 42 USPQ2d 1777, 1781 (Fed. Cir. 1997), the patentee argued that the claim term "passage" should be given its ordinary and accustomed meaning, and that the district court had erred by limiting the scope of the patent to the kind of "passage" employed in the preferred

embodiment. The court rejected that argument on two grounds. First, it noted that "all of the 'passage' structures contemplated by the written description [were] either non-smooth or conical." In addition, the written description "expressly distinguishe[d] over prior art passages by stating that those passages are generally smooth-walled." *Id.*, 42 USPQ2d at 1781. The court therefore concluded that "one skilled in the art reading the claims, description, and prosecution history would conclude that the term 'passage' ... does not encompass a smooth-walled, completely cylindrical structure." *Id.*

Finally, we find instructive the analysis in *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065 (Fed. Cir. 1999). The patent at issue described and claimed a hand-held convertible vacuum-blower for vacuuming and blowing leaves and yard debris. In the claimed device, the cover was fitted with a ring that restricted the size of the air inlet when the device was being used in blower mode. One of the questions before the court was whether the cover, which the claim characterized as "including" a restriction ring, had to be permanently attached to the restriction ring. To answer that question the court looked to the specification. The court observed that the specification and drawings showed the ring as part of and permanently attached to the cover, and did not illustrate or describe any other structure. Indeed, the court pointed out, the specification described the advantages of the unitary structure as important to the invention. Based on the specification, the court construed the term "including" in the asserted claims as requiring that the restriction ring be attached to the cover. 199 F.3d at 1302, 53 USPQ2d 1069-70.

The analysis in these cases is directly applicable to the claim construction issue presented here. At various points, the common specification of the three patents indicates that

the claimed invention uses coaxial, rather than side-by-side lumens, i.e., that the guide wire lumen is contained within the inflation lumen and that the inflation lumen is annular. Read together, these portions of the common specification lead to the inescapable conclusion that the references in the asserted claims to an inflation lumen "separate from" the guide wire lumen must be understood as referring to coaxial lumens, and thus that the asserted claims read only on catheters having coaxial lumens.

First, the abstract of each of the patents refers to the intermediate sleeve section of the invention as including "an inner core tube which defines a guide wire lumen." The abstract adds that the inflation lumen is "continued as an annular inflation lumen" through the sleeve section of the catheter. Thus, from the outset the specification identifies the inflation lumen, as that term is used in the SciMed patents, as annular, i.e. coaxial rather than dual in structure.

Second, in discussing the disadvantages of certain prior art structures, the written description of each of the patents explains that the prior art catheters with shortened guide wire lumens "suffer from several disadvantages." The first cited disadvantage is that "[s]uch catheters have been one piece polyethylene catheters having dual lumen configurations adjacent their distal regions. Typically, such catheters have larger than necessary shaft sizes and are stiffer in their distal regions than would be desired...." '594 patent, col. 3, ll. 3-8; '482 patent, col. 3, ll. 5-10; '334 patent, col. 3, ll. 10-15. Thus, the SciMed patents distinguish the prior art on the basis of the use of dual lumens and point out the advantages of the coaxial lumens used in the catheters that are the subjects of the SciMed patents. That discussion in the written description supports the district court's conclusion that the claims should not be read so broadly as to encompass the distinguished prior art structure. *See, e.g., Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159. 47 USPQ2d

1829, 1833 (Fed. Cir. 1998) (specification distinguished prior art as inferior and touted advantages of a conical shaped cup for use in an artificial hip device; "[s]uch statements make clear that the '589 patent discloses *only* conical shaped cups and nothing further"); *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304, 41 USPQ2d 1364, 1368 (Fed. Cir. 1997) ("[S]ince, by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover, he is by implication surrendering such protection.").

Third, the "Summary of the Invention" portion of the patents describes "the present invention" as having a sleeve section with an inner core tube having a guide wire lumen extending through it and an outer sleeve defining "a longitudinally extending annular inflation lumen." '594 patent, col. 3, ll. 33-45; '482 patent, col. 3, ll. 34-46; '334 patent, col. 3, ll. 40-52. The characterization of the "present invention" includes several more references to the "annular inflation lumen" as well, *see* '594 patent, col. 3, ll. 58-59, 61, col. 4, ll. 43-44; '482 patent, col. 3, ll. 59-60, 62, col. 4, ll. 45-46; '334 patent, col. 3, ll. 65, 68, col. 4, ll. 51-52, and the "Conclusion" section of the written description again refers to the "guide wire lumen and annular inflation lumen" in the distal portions of the catheter. '594 patent, col. 14, ll. 26-28; '482 patent, col. 14, ll. 31-33; '334 patent, col. 3, ll. 41-44. As in the *Wang Labs* and *Modine* cases cited above, the characterization of the coaxial configuration as part of the "present invention" is strong evidence that the claims should not be read to encompass the opposite structure.

The most compelling portion of the specification, and the portion on which the district court principally focused, is the passage in the section entitled "Catheter Intermediate Sleeve Section" in which the inflation lumen is described as annular in structure, being formed from an outer sleeve or tube (the inflation lumen) and an inner core tube (the guide wire

lumen). *See* '594 patent, col. 7, ll. 26-28, 63-65; '482 patent, col. 7, ll. 29-31, 66-68; '334 patent, col. 7, ll. 41-43, col. 8, ll. 10-12. The patents then recite:

> The intermediate sleeve structure defined above is the basic sleeve structure for *all embodiments of the present invention contemplated and disclosed herein*--namely, an inner core tube bonded to a distal portion of the main catheter shaft, with an outer sleeve forming an annular continuation of the inflation lumen through the main shaft between the core tube and outer sleeve. As discussed below and illustrated herein, various configurations of the connections and components relative to the formation of the distal guide wire lumen, including the coupling of the main shaft to the intermediate sleeve section, are contemplated.

'594 patent, col. 8, ll. 3-14; '482 patent, col. 8, ll. 6-17; '334 patent, col. 8, ll. 18-29 (emphasis added).

This language defines SciMed's invention in a way that excludes the dual, or side-by-side, lumen arrangement. SciMed argues that the references to the annular inflation lumen are meant only to refer to the preferred embodiment of the invention, and not to indicate that the claims should be construed as limited to a structure employing coaxial lumens. That argument, however, flies in the face of the many statements in the written description that define "the invention" as employing a coaxial lumen structure and distinguish the prior art in part on the ground that it used a dual lumen structure, which had the disadvantage of making the shaft sizes of the catheters larger than necessary and making the catheters "stiffer in their distal regions than would be desired." '594 patent, col. 3, ll. 3-9; '482 patent, col. 3, ll. 5-11; '334 patent, col. 3, ll. 10-16. SciMed's argument is particularly unconvincing in the face of its own statement in the written description that the structure

containing coaxial lumens ("namely, an inner core tube bonded to a distal portion of the main catheter shaft, with an outer sleeve forming an annular continuation of the inflation lumen through the main shaft between the core tube and the outer sleeve") is "the basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein." '594 patent, col. 8, ll. 4-9; '482 patent, col. 8, ll. 7-12; '334 patent, col. 8, ll. 19-24. That characterization of the invention cannot reasonably be interpreted as limited to the preferred embodiment, as SciMed argues, but is expressly made applicable to "all embodiments of the present invention."

The words "all embodiments of the present invention" are broad and unequivocal. It is difficult to imagine how the patents could have been clearer in making the point that the coaxial lumen configuration was a necessary element of every variant of the claimed invention. Moreover, there is no suggestion that the patentee made that statement unaware of the alternative dual lumen configuration, because earlier in the patent the patentee had distinguished the dual lumen configuration used in prior art devices as having disadvantages that the coaxial lumens used in the patented invention had overcome. *See* '594 patent, col. 3, ll. 1-22; '482 patent, col. 3, ll. 3-24; '334 patent, col. 3, ll. 8-29. (describing the dual lumen configuration). This is therefore a clear case of disclaimer of subject matter that, absent the disclaimer, could have been considered to fall within the scope of the claim language.

Citing *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998), and *Johnson Worldwide Assocs. v. Zebco Corp.* , 175 F.3d 985, 989-90, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999), SciMed argues that the only way in which statements in the written description can restrict the scope of a claim is by setting forth a specific, narrowing definition for a particular

claim term. As indicated by the cases discussed above, such as *Watts*, *Wang Labs*, *Cultor*, and *Tekmar*, SciMed's characterization of the role of the written description is too narrow. While it is true, of course, that "the claims define the scope of the right to exclude" and that "the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim," *Renishaw PLC*, 158 F.3d at 1248, 48 USPQ2d at 1121, the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format. *See, e. g., Phonometrics, Inc. v. Northern Telecom Inc.*, 133 F.3d 1459, 1466, 45 USPQ2d 1421, 1426-27 (Fed. Cir. 1998); *Gen. Am. Transp. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 769-70, 39 USPQ2d 1801, 1803-04 (Fed. Cir. 1996); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1577-78, 27 U.S.P.Q.2d 1837, 1840-41 (Fed. Cir. 1993); *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1566, 1567 (Fed. Cir. 1992). In this case, the written description makes clear that when the asserted claims refer to the respective locations of the guide wire and inflation lumens, and in particular when the claims refer to the inflation lumen as "extending through the catheter separate from" the guide wire lumen, the claim language refers to coaxial lumens.

Because the three SciMed patents make clear that the lumens referred to in the claims are all coaxial in structure, the district court was correct to construe the patents as disclaiming the dual lumen configuration. Under such a construction, SciMed concedes that no literal infringement can be found. The district court therefore properly entered summary judgment in favor of ACS on the issue of literal infringement.

III

In a separate opinion, the district court rejected SciMed's argument that ACS's accused devices infringed the three asserted patents under the doctrine of equivalents. We agree with the court that the doctrine of equivalents is inapplicable in this case and that the district court properly granted summary judgment to ACS on that issue.

As noted above, the common specification of SciMed's patents referred to prior art catheters, identified them as using the dual lumen configuration, and criticized them as suffering from the disadvantages of having "larger than necessary shaft sizes" and being "stiffer in their distal regions than would be desired." '594 patent, col. 3, ll. 6-8; '482 patent, col. 3, ll. 8-10; '334 patent, col. 3, ll. 13-15. That criticism of the dual lumen configuration was consistent with the evidence from SciMed witnesses and documents, which noted the advantages of the coaxial lumen configuration in increasing the flexibility of catheters and their ability to track through the coronary arterial system. The disclaimer of dual lumens was made even more explicit in the portion of the written description in which the patentee identified coaxial lumens as the configuration used in "all embodiments of the present invention."

Having specifically identified, criticized, and disclaimed the dual lumen configuration, the patentee cannot now invoke the doctrine of equivalents to "embrace a structure that was specifically excluded from the claims." *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400, 29 USPQ2d 1767, 1771 (Fed. Cir. 1994). A particular structure can be deemed outside the reach of the doctrine of equivalents because that structure is clearly excluded from the claims whether the exclusion is express or implied. In *Moore, U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 56 USPQ2d 1225 (Fed. Cir. 2000), for example, the court considered a claim to a mailer-type business form in which

the longitudinal strips of adhesive extend "the majority of the lengths" of the longitudinal margins of the form. The patentee argued that the accused form, in which the longitudinal strips of adhesive extended a minority of the length of the longitudinal margin of the form, infringed under the doctrine of equivalents. The court rejected the argument, holding that "it would defy logic to conclude that a minority--the very antithesis of a majority--could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise." 229 F.3d at 1106, 56 USPQ2d at 1236. Similarly, in *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 42 USPQ2d 1737 (Fed. Cir. 1997), the patent claimed a process that included crystallizing a particular substance at high temperature "under an inert gas atmosphere." The patentee argued that certain of the accused processes, which used "heated air" rather than "an inert gas atmosphere" infringed under the doctrine of equivalents. The court rejected that argument, explaining that "the claim language specifically excludes reactive gases--such as 'heated air'--from the scope of the claims" and in light of that specific exclusion, the accused processes could not infringe under the doctrine of equivalents. 114 F.3d at 1561, 42 USPQ2d at 1747. In each of these cases, by defining the claim in a way that clearly excluded certain subject matter, the patent implicitly disclaimed the subject matter that was excluded and thereby barred the patentee from asserting infringement under the doctrine of equivalents.

The court did effectively the same thing in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 44 USPQ2d 1103 (Fed. Cir. 1997). In that case, the claim was to a syringe disposal container having an elongated slot at the top of the container body and a "first constriction extending over said slot." Although those limitations did not literally read on the accused device, the patentee argued that

the device infringed under the doctrine of equivalents. The court rejected that argument, noting that the claim

> defines a relatively simple structural device. No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of this limitation at the time of its incorporation into the claim. . . . If Sage desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances. . . . [A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.

126 F.3d at 1425, 44 USPQ2d at 1107. Thus, the court determined that because the scope of the claim was limited in a way that plainly and necessarily excluded a structural feature that was the opposite of the one recited in the claim, that different structure could not be brought within the scope of patent protection through the doctrine of equivalents. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1317, 47 USPQ2d 1272, 1277 (Fed. Cir. 1998) (subject matter is "specifically excluded" from coverage under the doctrine of equivalents if its inclusion is "inconsistent with the language of the claim").

Finally, in *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996), the court addressed a claim directed to a system for stringing tennis rackets with splayed strings. The court construed the claim to require that the stringing system produce rackets with at least three different splay-creating offset distances for the strings. Having construed the claim

in that manner, the court held that, for purposes of the doctrine of equivalents, "the properly construed claim *cannot* have an equivalent in a racket with only two offset distances," i.e., the two-distance splayed string system was "specifically excluded from the scope of the claims." 73 F.3d at 1582, 37 USPQ2d at 1373 (quoting *Dolly*, 16 F.3d at 400, 29 USPQ2d at 1771). *See also Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408, 1416, 54 USPQ2d 1141, 1147 (Fed. Cir. 2000) ("[N]o reasonable jury could find that a stop which extends to the peripheral edge of a disk is equivalent to one that is 'substantially inward' of the very same disk."); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 541, 41 USPQ2d 1023, 1029 (Fed. Cir. 1996) (doctrine of equivalents does not extend to an accused device in which "the required structure is specifically excluded" by the patent).

The principle articulated in these cases is akin to the familiar rule that the doctrine of equivalents cannot be employed in a manner that wholly vitiates a claim limitation. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29-30, (1997); *Athletic Alternatives*, 73 F.3d at 1582, 29 USPQ2d at 1771 ("specific exclusion" principle is "a corollary to the 'all limitations' rule"). Thus, if a patent states that the claimed device must be "non-metallic," the patentee cannot assert the patent against a metallic device on the ground that a metallic device is equivalent to a non-metallic device. The unavailability of the doctrine of equivalents could be explained either as the product of an impermissible vitiation of the "non-metallic" claim limitation, or as the product of a clear and binding statement to the public that metallic structures are excluded from the protection of the patent. As the court made clear in *Sage*, the foreclosure of reliance on the doctrine of equivalents in such a case depends on whether the patent clearly excludes the asserted equivalent structure, either implicitly or explicitly.

In that respect, this case is an even stronger one for not applying the doctrine of equivalents than cases such as *Dolly*, *Sage*, *Eastman Kodak*, *Moore*, and *Athletic Alternatives*. Each of the SciMed patents specifically recognized and disclaimed the dual lumen structure, making clear that the patentee regarded the dual lumen configuration as significantly inferior to the coaxial lumen configuration used in the invention. Where such an explicit disclaimer is present, the principles of those cases apply *a fortiori*, and the patentee cannot be allowed to recapture the excluded subject matter under the doctrine of equivalents without undermining the notice function of the patent. As the court observed in *Sage*, the patentee had an opportunity to draft the patent in a way that would make clear that dual lumens as well as coaxial lumens were within the scope of the invention, but the patentee did just the opposite, leaving competitors and the public to draw the reasonable conclusion that the patentee was not seeking patent protection for catheters that used a dual lumen configuration. Under these circumstances, the district court was justified in concluding that a reasonable jury could not find that the accused devices infringe the SciMed patents under the doctrine of equivalents.

AFFIRMED.

DYK, *Circuit Judge*, concurring.

On the facts of this particular case, I agree with the result reached by the majority, and I join the opinion. I also agree with the majority that "the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format." The problem is that our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when

it is not appropriate to do so. Until we provide better guidance, I fear that the lower courts and litigants will remain confused.

APPENDIX B

INTELLECTUAL PROPERTY TODAY

NARROW CLAIMING AND THE SCOPE OF EQUIVALENTS[1]

BY CORWIN P. UMBACH, PH.D., OF OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

March 2001

"I meant what I said And I said what I meant....".[2]

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Federal Circuit decisions over the past five years have shown that what is meant in a patent as the scope of the invention can in some circumstances actually be found in the claims. A court can find, even in the absence of limiting prosecution history or prior art, a limited scope of equivalents for narrowly drawn claims. A stark demonstration of the limiting effect of narrow claim language is found in the recent decision in *Moore U.S.A., Inc. v. Standard Register Co.*[3], where the Federal Circuit held that 47.8% is not an equivalent of a claimed "majority" (i.e., 50.001%+).

Under the doctrine of equivalents, a product or process

that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention.[4] Equivalence is a question of fact[5] based on insubstantial differences between the accused product or process and the claimed elements.[6] The essential inquiry is whether the accused product or process contains elements identical or equivalent to each claimed element of the patented invention.[7] The doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole.[8] The doctrine of equivalents cannot effectively eliminate an element in its entirety.[9] The prosecution history[10] of a patent and the prior art[11] both serve as legal limits to the scope of equivalents.

The doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.[12] There is an inherent conflict between the role of the doctrine of equivalents in preventing a fraud on the patent' and the primacy of the claims in defining the scope of a patentee's exclusive rights.[13]

Over the past five years the Federal Circuit has issued a series of decisions developing a framework for restricting the scope of equivalents based on narrow claim language. In one approach, the Federal Circuit has focused on whether embodiments disclosed, but not claimed, were "distinct" enough from claimed embodiments to exclude the unclaimed embodiments as equivalents. In a second approach, the Federal Circuit has relied on the "foreseeability" of the limiting potential of "clear structural limitations" to limit equivalents. In a third approach, the Federal Circuit in an unpublished opinion relied on "clear definite numerical limitations". The Federal Circuit used all three approaches, either explicitly or implicitly, in reaching the *Moore*

decision.

EMBODIMENTS THAT ARE "DISTINCT", BUT NOT CLAIMED

The 1996 Federal Circuit decision in *Maxwell v. J. Baker, Inc.*[14] (Lourie, Skelton and Schall) signaled that "subject matter disclosed by not claimed in a patent application is dedicated to the public".[15] The Maxwell patent concerns fastening tabs in shoes. A plastic filament passing through the fastening tabs keeps a pair of shoes together for display in stores. The patent disclosed and claimed a first embodiment in which a portion of a fastening tab was positioned between the inner and outer soles on the bottom of the shoe. In addition, the patent disclosed, but did not claim, an alternative embodiment in which the fastening tab was stitched into a lining seam of the shoes at the sides or back of the shoes. Because the patent did not claim the alternative embodiment, the Federal Circuit found that Maxwell dedicated the alternative embodiment to the public.

In 1998 the *Federal Circuit in YBM Magnex Inc. v. International Trade Commission*[16] (Rich, Smith and **Newman**) clarified the *Maxwell* decision and indicated that a patent disclosing two ***distinct*** embodiments, while claiming only one, could not enforce the unclaimed embodiment as an equivalent of the embodiment that was claimed.[17] Thus, the *YBM Magnex* court reasoned that in *Maxwell* a fastening tab attached to the bottom of a shoe and a fastening tab attached to the side of a shoe were distinct embodiments. Because only one of these distinct embodiments was claimed, the other was dedicated to the public.

In *YBM Magnex*, in contrast to *Maxwell*, the Federal Circuit declined to find distinct embodiments. YBM was the owner of a patent with claims directed to "[a] permanent magnet alloy consisting essentially of, in weight percent, ... 6,000 to 35,000 ppm oxygen ... ." The patent disclosed, but did not claim, oxygen contents in the range between 5,450

and 6,000 ppm. The Federal Circuit found that *Maxwell* did not foreclose, as a matter of law, application of the doctrine of equivalents to encompass oxygen contents of 5,450 to 6,000 ppm.

The utility of the "distinct, but not claimed, embodiment" approach to limiting the scope of equivalents of narrow claims is questionable at present. What makes one embodiment "distinct" and another not? Until the Federal Circuit defines a "distinct embodiment", instead of simply concluding the existence of more than one, the approach provides little guidance to the public. Interestingly, while Judge Newman authored the *YBM Magnex* opinion advancing the "distinct, but not claimed, embodiment" approach, in the *Moore* decision (discussed below) Judge Newman dissented against the panel majority's finding of a distinct, unclaimed embodiment dedicated to the public.[18] It would appear that what now passes as a "distinct embodiment" is in the eye of the beholder.

"FORESEEABLE" LIMITING POTENTIAL OF "CLEAR STRUCTURAL LIMITATIONS"

The second approach to limiting the scope of equivalents of narrow claims is found in the 1997 Federal Circuit decision in *Sage Products Inc. v. Devon Industries Inc.*[19] (Mayer, **Rader** and Schall). This approach focuses on the "foreseeable" limiting potential of "clear structural limitations". In *Sage Products*, the Federal Circuit affirmed a summary judgment that an accused medical waste disposal container with two interior constrictions and a slot between the two interior constrictions is not an equivalent of a disposal container with "an elongated slot at the *top* of the container body" and "a barrier means comprising a first constriction extending *over* said slot". After finding that the limitation "top" meant "highest point" and the limitation "over" meant "above", the Federal Circuit concluded that each of the patentee's theories of infringement by

equivalents would improperly eliminate at least one limitation from the claims.

The Federal Circuit emphasized that:

> "Because this issued patent contains clear structural limitations, the public has a right to rely on those limits in conducting its business activities. This court will not remove such a limitation under a doctrine designed to prevent fraud on a patent'".[20] (emphasis added)

> "...[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of his failure to seek protection for this foreseeable alteration of its claimed structure."[21] (emphasis added)

> "For a patentee who has claimed an invention narrowly, there may not be infringement under the doctrine of equivalents in many cases, even though the patentee might have been able to claim more broadly. If it were otherwise, then claims would be reduced to functional abstracts, devoid of meaningful structural limitations on which the publish could rely."[22] (emphasis added)

Thus, in *Sage Products*, the Federal Circuit found that "clear structural limitations" with foreseeably narrow meanings could restrict the scope of equivalents. However, the Federal Circuit provided little guidance to the public regarding what is, and is not, clearly structural and "foreseeable".

In *Tanabe Seiyaku Co. v. International Trade Commission*[23] (**Plager**, Schall and Bryson), the Federal Circuit affirmed a decision by the ITC that an accused process did not infringe a claim directed to a method of preparing a benzothiazeprine derivative. The Federal Circuit

concluded that in *Tanabe Seiyaku* the accused process using butanone (CH_3-CH_2-CO-CH_3) was not an equivalent of the claimed process using acetone (CH_3-CO-CH_3). The relevant limitation recited "acetone", which is a species of the genus "lower alkyl ketone". Because "lower alkyl acetate" was disclosed in the specification, the Federal Circuit reasoned that the skilled artisan would know that the patentee could have used the term "lower alkyl ketone" to describe a class of ketone solvents including butanone and acetone, if the patentee had so intended. Because the patentee did not due so, but instead sharply restricted the claims, the scope of equivalents was correspondingly narrow.[24] Thus, in *Tanabe Seiyaku* the Federal Circuit indicated that reciting a narrow chemical species in a claim, when use of a broader chemical genus including the species is foreseeable, will exclude compounds falling within the genus other than the species from the scope of equivalents of the species.

In *Overhead Door Corp. v. Chamberlain Group Inc.*[25] (Michel, **Rader** and Schall) the Federal Circuit did ***not*** find "clear structural limitations" that would limit equivalents. In *Overhead Door*, the Federal Circuit overruled a summary judgment that a software-driven memory selection system was outside the scope of equivalents of a hardware memory selection switch as a matter of law. The Federal Circuit found that the district court's reliance on *Sage Products* was inappropriate because the patent at issue did not contain any clear structural limitations that would preclude a reasonable jury from finding a software system to be equivalent to the claimed hardware. In contrast to the situation in *Sage*, application of the doctrine of equivalents to cover the accused software did not vitiate the "memory selection switch" element.[26]

In *Zodiac Pool Care Inc. v. Hoffinger Industries Inc.*[27] (Bryson, Skelton and **Gajarsa**), the Federal Circuit affirmed a judgment as a matter of law that an accused pool cleaning

system did not include an equivalent of a stop, for preventing upward flexing of a peripheral edge of a flexible disc surrounding a water inlet, that was "*substantially inward* of the peripheral edge". The Federal Circuit refused to consider function/way/result issues in view of "clear structural limitations" present in the claims and absent in the accused system. Relying heavily on *Sage Products*, the Federal Circuit found that no reasonable jury could find that an accused stop which extends to the peripheral edge of a disk is equivalent to one that is "substantially inward" of the very same disk.[28] To the Federal Circuit, the two stops were "not even close".[29] Thus, in *Zodiac Pool Care* the Federal Circuit reiterated its decision in *Sage Products* that clear structural limitations alone can limit the scope of equivalents.

In *Vehicular Technologies Corp. v. Titan Wheel International Inc.*,[30] (Plager, Clevenger and Rader, **per curiam**) the Federal Circuit affirmed a summary judgment that, as a matter of law, an accused spring assembly including a single spring and a plug fitted into the spring and bearing against a pin is not the equivalent of a "spring assembly consisting of two concentric springs bearing against one end of [a] pin". The Federal Circuit found that the claimed two spring assembly performed a key backup function that was not performed by the accused device. However, rather than considering differences in this function on the scope of equivalents, the court focused on the requirement in the claim that two springs be present. While acknowledging that the recitation "consisting of" did not foreclose infringement by equivalents, the court felt that this recitation emphasized that, to infringe by equivalents, an infringing structure had to include two springs. In a concurring opinion, Judge Rader likened *Vehicular Technologies Corp. to Sage Products, Inc.*, finding that a skilled patent drafter would have readily seen the limiting potential of the "consisting of two concentric springs" limitation as excluding from equivalents structures with

fewer than two springs. Judge Rader had little sympathy for the patentee, who had learned of the accused infringement during the two year period allowed for reissuing, but failed to amend the claims to cover the accused single spring device.

CLEAR, DEFINITE NUMERICAL LIMITATIONS

A third approach limiting the scope of equivalents of narrow claims is found in the March 31, 1998, Federal Circuit decision in *Brunswick Corp. v. U.S.*[31] (Mayer, Newman and **Clevenger**)(unpublished), prior to the *YBM Magnex* decision on May 27, 1998, discussed above. The *Brunswick* court assertedly followed the holding in *Maxwell* that "subject matter that is disclosed in the specification, but not claimed, is dedicated to the public". The *Brunswick* majority affirmed a finding by the U.S. Court of Federal Claims that certain unmodified polyester/steel cloth screens did not infringe a patent directed to radar camouflage screens under the doctrine of equivalents.

In *Brunswick*, the claimed camouflage included an electrically resistive layer having, at radio frequencies exceeding 2000 MHz, "a surface resistivity falling between a **lower limit** of 100 ohms and an **upper limit** of 1,000 but considerably different from 377 ohms".

However, in following *Maxwell*, the *Brunswick* majority focused on the limiting nature of the claims. Without being explicit, the panel majority appeared to be focusing on differences in how numerical ranges are claimed to decide whether or not the numerical limitations limit the scope of equivalents.

> "Nor do we understand the rule of *Maxwell*, supported by the broad concept of dedication to the public of disclosed but unclaimed matter, to be any less applicable to a case in which a **clear, definite numerical limitation** is placed on a claimed range

> than to a case in which an alternative configuration of an article is disclosed but not claimed. In any event, this case certainly does not mean that all subject matter outside the literal claims, of whatever nature, is dedicated to the public in all situations."[32] (emphasis added).

Thus, while ostensibly following *Maxwell*, the panel majority appeared to find that a "clear, definite numerical limitation" can, by itself, limit the scope of equivalents of a numerical limitation, much the same as *Sage Products* found that a "clear structural limitation" can, by itself, limit the scope of equivalents of a structural limitation. Although the scope of equivalents sought by *Brunswick* included surface resistivities disclosed in the specification, because the accused product was outside the definite limits recited in the claim, the panel majority found no infringement by equivalents. Thus, in *Brunswick* the recitation of "lower **limit**" and "upper **limit**" limited numerical equivalents to the recited range. The majority contrasted "lower limit" and "upper limit" with less definite limitations such as "relatively small", "about" and "approximately", which presumably do not limit numerical equivalents.[33]

THE MOORE DECISION

The three approaches discussed above came together in the September 22, 2000, decision *Moore U.S.A., Inc. v. Standard Register Company*[34] (Newman, **Michel** and Clevenger). In *Moore*, the Federal Circuit affirmed a summary judgment that an accused mailer type business form, with adhesive running 47.8% of the length of margin, did not, as a matter of law, infringe by equivalents a claim in which the adhesive extended a "majority" of the length of the margin.

In emphasizing the second approach ("foreseeable" limiting potential of "clear structural limitations" from *Sage*) to limiting the scope of equivalents of narrow claims, the

court focused on the foreseeable narrowness of the claimed "majority".

> "If our case law on the doctrine of equivalents makes anything clear, it is that all claim limitations are not entitled to an equal scope of equivalents. Whether the result of the All Limitations Rule [citation omitted], prosecution history estoppel [citation omitted], or the **inherent narrowness of the claim language** [citation omitted], many limitations warrant little, if any, range of equivalents.
>
> In this case, we hold that the applicant's use of **the term "majority" is not entitled to a scope of equivalents covering a minority** for at least two reasons. First, to allow what is undisputedly a minority (i.e. 47.8%) to be equivalent to a majority would vitiate the requirement that the "first and second longitudinal strips of adhesive ... extend the majority of the length of said longitudinal marginal portions." [citation to 464 patent omitted]. If a minority could be equivalent to a majority, this limitation would hardly be necessary, since the immediately preceding requirement of a "first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face" would suffice. Second, it would defy logic to conclude that a minority — the very antithesis of a majority — could be insubstantially different from a claim limitation requiring a majority, and **no reasonable juror could find otherwise**."[35] (emphasis added)

The court also applied the first approach ("distinct, but unclaimed, embodiments" from *Maxwell* (as clarified in *YBM Magnex*)) to limiting the scope of equivalents of narrow claims:

> "[W]hile Moore argues that the written description's teaching that the length of the first and second strips may be about "half of the length" of the longitudinal marginal portions gives rise to a scope of equivalents that would cover a "minority," our case law reveals that Moore is mistaken. In *Maxwell v. J. Baker, Inc.* [citation omitted], we explained the contrary principle the "subject matter disclosed in the specification, but not claimed, is dedicated to the public" in determining infringement under the doctrine of equivalents. Id. at [citation omitted]. Having fully disclosed two **distinct** embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, Moore is not entitled to "enforce the unclaimed embodiment as an equivalents of the one that was claimed." *YBM Magnex, Inc. v. International Trade Comm'n* [citation omitted].[36] (emphasis added)

The third approach ("clear, definite numerical limitations" from *Brunswick*) to limiting equivalents is also implicit in *Moore*, because the structure at issue in the accused product was no different than the structure featured in the claim. Both structures were strips of adhesive. Only the numbers associated with the lengths of the strips were different.

Thus, the *Moore* decision marked the coming together of the three approaches used in recent years by the Federal Circuit to limit equivalents of narrow claims. Particularly remarkable in *Moore* is the majority's willingness, despite the disclosure of adhesive strips running less than a majority of the margin, to draw a clear distinction between 47.8% and 50+%, and to exclude 47.8% from the Moore invention,

based on Moore's choice of "majority" as an explicit claim limitation.

WHAT WILL BE HATCHED IN THE FUTURE?

The recent decisions culminating in *Moore* show that the Federal Circuit is willing to find legal limits on the scope of equivalents based solely on the narrowness of claim limitations. The narrow limitations can be structural or numerical.

What the Federal Circuit will, and will not, consider to be a "clear structural limitation" with "foreseeable" limiting potential remains to be seen.

On the other hand, the cases provide some guidance regarding what the Federal Circuit will consider to be a "clear, definite numerical limitation" that limits the scope of equivalents.

It appears that the Federal Circuit will restrict equivalents of claim limitations asserting, for whatever reason, an abrupt boundary to a range of numbers defining an invention. The assertion of an abrupt boundary can be found in the explicit or implicit use of imperative claim language.

For example, in *Moore* the limitation "majority", which cannot encompass a minority, implicitly means "*no less than* greater than 50%". The imperative "no less than" means that anything "less than" is outside the invention.

Similarly, in *Brunswick* the recitation of lower and upper "limits" expresses a imperative that anything outside the bounds set by the limits is outside the invention.

In light of *Brunswick* and *Moore*, it appears that the Federal Circuit will probably find that imperative claim language (explicit or implicit) such as "no less (greater) than", "not less (greater) than" and "at least (most)" (which is similar in tone and meaning to "not less (greater) than")

will sharply limit equivalents, much like *Moore's* "majority". To find an equivalent outside the range defined by one of these imperative limitations would impermissibly eliminate from a claim the imperative feature of the limitation.

What numerical language will not limit equivalents? *Brunswicks* comparison of a lower "limit" and an upper "limit" with inexact terms such as "relatively small", "about" and "approximately" indicates that inexact limitations such as "from about A to about B" do not limit numerical equivalents. *YBM Magnex*, e.g., confirms that an explicit recitation of a numerical range such as "from A to B" also does not limit equivalents. Because claim language such as "less (greater) than A" replaces "less(greater) than" for the B end of a range "from A to B", without asserting anything about the A end of the range, claim language such as "less (greater) than A" should not limit equivalents of the A endpoint. Thus, the recitation of a numerical range without expressing an imperative should not limit the scope of numerical equivalents.

Thus, it appears that substitution of "greater than 50%" for the "majority" limitation in *Moore* would have avoided the sharply restricted scope of equivalents accorded the Moore claims.

Following *Moore*, it becomes even more important that the claim drafter say in the claim what the drafter means, and mean what the drafter says, so that the drafter remains "faithful one hundred per cent" to whatever has been invented.

ENDNOTES

[1] © Corwin P. Umbach 2000.

[2] "I meant what I said
And I said what I meant....
An elephant's faithful
One hundred per cent!"
Geisel, Theodor Seuss, *Horton Hatches The Egg*,

Random House, New York (c. 1968)

[3] *Moore U.S.A. Inc. v. Standard Register Co.*, 56 USPQ2d 1225 (Fed. Cir. 2000).

[4] *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 USPQ2d 1865, 1868 (1997), *citing Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 85 USPQ 328, 330-331 (1950).

[5] *Hilton Davis Chemical co. v. Warner-Jenkinson Co. Inc.*, 36 USPQ2d 1641, 1647 (Fed. Cir. 1995).

[6] *Id.*, at 1645.

[7] *Warner-Jenkinson*, at 1875.

[8] *Id.*, at 1871.

[9] *Id.*.

[10] *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. 2000). In this en banc decision the Federal Circuit rejects its previous "flexible bar approach" and adopts a "strict rule of complete surrender" of equivalents when a claim element is narrowed by amendment during prosecution. In stressing the need for certainty as to the scope of patent protection, the *Festo* court emphasizes the public-notice function of patent claims as being paramount. While *Festo* does not address the narrow claiming issues discussed in this article, the *Festo* theme of public-notice is apparent in the Federal Circuit's recent approach to the scope of equivalents of narrow claims.

[11] *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 14 USPQ2d 1942 (1990).

[12] *Warner-Jenkinson*, at 1871.

[13] *Sage Products Inc. v. Devon Industries Inc.*, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997), *citing Charles Geiner & Co. v. Mari-Med Mfg., Inc.*, 22 USPQ2d 1526, 1529 (Fed. Cir. 1992).

[14] *Maxwell v. J. Baker, Inc.*, 39 USPQ2d 1001 (Fed.Cir. 1996)

[15] *Id.*, at 1006.

[16] *YBM Magnex Inc. v. International Trade Commission*, 46 USPQ2d 1843 (Fed. Cir. 1998).

[17] *Id.*, at 1846.

[18] *Moore*, at 1246.

[19] *Sage Products Inc. v. Devon Industries Inc.*, 44 USPQ2d 1103 (Fed. Cir. 1997).

[20] *Sage Products*, at 1108.

[21] *Id.*, at 1107.

[22] *Id.*

[23] *Tanabe Seiyaku Co. v. International Trade Commission*, 41 USPQ2d 1976 (Fed. Cir. 1997).

[24] *Id.*, at 1982.

[25] *Overhead Door Corp. v. Chamberlain Group Inc.*, 52 USPQ2d 1321 (Fed. Cir. 1999).

[26] *Id.*, at 1327.
[27] *Zodiac Pool Care Inc. v. Hoffinger Industries Inc.*, 54 USPQ2d 1141 (Fed. Cir. 2000)
[28] *Id.*, at 1147.
[29] *Id.*
[30] *Vehicular Technologies Corp. v. Titan Wheel International Inc.*, 54 USPQ2d 1841 (Fed. Cir. 2000).
[31] *Brunswick Corp. v. U.S.*, 46 USPQ2d 1446 (Fed. Cir. 1998)(unpublished).
[32] *Id.*, at 1450.
[33] *Id.*
[34] *Moore, supra.*
[35] *Id.*, at 1235-1236.
[36] *Id.*, at 1236.

APPENDIX C

AMERICAN LAWYER MEDIA
THE LEGAL INTELLIGENCER

What's Left of the Doctrine of Equivalents?

By Steven E. Koffs

January 4, 2001

The U.S. Court of Appeals for the Federal Circuit altered the face of patent litigation with its sweeping en banc decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 2000 U.S. App. LEXIS 29979, 56 U.S.P.Q.2d (BNA) 1865* (Fed. Cir. Nov. 29, 2000). The Festo decision marks a swing of the pendulum away from broad expansion of patent rights under the judicially created doctrine of equivalents and towards greater certainty in the scope of patents.

The patent statutes require a patent applicant to particularly point out and distinctly claim the subject matter regarded as the invention. The scope of any patent that issues is then limited by the claims. The courts have long recognized that an infringer should not be able to avoid liability for infringement by changing only minor or insubstantial details of a claimed invention. The doctrine of equivalents was created to strike a balance between ensuring that the patentee enjoys the full benefit of her patent and ensuring that the claims of the issued patent give the public fair notice of what subject matter is protected by the patent. Under the doctrine of equivalents, an infringer who makes a minor, insubstantial change to one of the claimed features but literally practices all the remaining elements of the claimed invention is still liable. Prosecution history estoppel

provides a limit to the expansion of patent scope under the doctrine of equivalents. Upon issuance of a patent, the full written record before the patent office is opened to the public. If the applicant had amended his or her application or argued a position before the patent examiner in order to obtain a patent, the patent owner is subsequently prevented from expanding the patent under the doctrine of equivalents to cover the subject matter that was surrendered before the patent office. Prosecution history estoppel protects the public-notice function of the claims. In spite of these seemingly simple rules, application of the doctrine of equivalents has long remained one of the most difficult and contentious tasks in patent litigation. The answers to two broad questions remained elusive: Under what circumstances is subject matter surrendered? How much is surrendered? Prior to the Festo decision, it was generally assumed that subject matter was only surrendered if the applicant amended the claims to distinguish the invention from the prior art or argued the importance of a distinguishing feature of the invention to overcome a prior-art rejection. Amendments that were made to clarify or render the claims more definite did not prevent the invocation of the doctrine of equivalents. Similarly, amendments to make the invention conform to one of the four statutory subject matter classes (process, machine, article of manufacture or composition of matter) did not preclude application of the doctrine of equivalents. It became common (some would say, automatic) for patentees to argue during litigation that the reason for an amendment was not to distinguish the invention from the prior art, but to make the claims more definite. Festo closed this door to patentees by holding that any amendment or argument made by the patentee related to any statutory requirement for patentability creates prosecution history estoppel. Estoppel is now created by amendments or arguments relating to any of the following additional criteria: membership of the

invention in one of the four statutory classes; the presence of an adequate written description of the invention in the original application; adequacy of the application to enable one skilled in the field to practice the claimed invention; and disclosure of the best mode of practicing the invention, definiteness of the claims or claiming the subject matter the applicant regards as the invention. The Festo decision also holds that voluntary amendments not made in response to any rejection by the examiner that narrow the claims create prosecution history estoppel in the same manner as involuntary amendments required by the patent examiner. The most controversial holding in the Festo case is that when a claim amendment creates prosecution history estoppel with regard to a claim element, there is no range of equivalents available for the amended claim element. Prosecution history estoppel creates a complete bar to the doctrine of equivalents. Previously, the Federal Circuit had frequently applied a flexible-bar approach, allowing application of the doctrine of equivalents where the accused device was not similar to the prior art that provoked the amendments. In rejecting this approach, the court explained that the paramount function of the claims is the notice function; the discarded flexible-bar approach did not produce consistent results or provide guidance to the marketplace. The Federal Circuit reaffirmed a previous holding that, when no explanation for a claim amendment is established, no range of equivalents is available for the amended claim element. In applying this rule in the Festo case, the Federal Circuit further required that, "In order to give due deference to public notice considerations . . . a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent's prosecution, i.e., the patent's prosecution history. "If there is no reason stated in the prosecution history, a patentee can no longer introduce extrinsic evidence in court to prove that the reason for the amendment was unrelated to patentability.

The Federal Circuit demonstrated these new rules by applying them to the facts of Festo. The court compared the canceled original claims to the later-added claims and determined that the differences constituted surrendered subject matter, even though the later-added claims were not "amended." The court also held that an amendment replacing a "means-plus-function" element defined by its function, instead of its structure with the corresponding structure was a narrowing amendment and precludes any range of equivalence for that element. In the past three years, the Federal Circuit has whittled away at the availability of the doctrine of equivalents in several different contexts. During this period, the Federal Circuit has repeatedly held that "inherently narrow" claim language can in some cases preclude any application of the doctrine of equivalents, regardless of the absence of prosecution history estoppel. For example, the court held that a claim requirement for a "majority" inherently could not be met under the doctrine of equivalents by 47.8 percent (stating that "a majority" cannot be insubstantially different from a minority) in *Moore U.S.A., Inc. v. Standard Register Co., 229 F.3d 1091, 56 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2000).* Further, the court has held that the doctrine of equivalents is generally not available for "means-plus-function" elements if there is no literal infringement, unless the accused device relies on later-developed technology to circumvent the claim limitation. See *Chiuminatta Concrete Concepts, Inc., v. Cardinal Industries Inc., 145 F. 3d 1303 (Fed. Cir. 1998).* Seen in the context of these other cases, the Festo decision appears to be just one more step on the road towards a patent system in which the literal claim language is almost always determinative, and the doctrine of equivalents is only available in a minimal number of cases unavoidably required by U.S. Supreme Court precedents. Although the rare patent application is allowed on its first examination, amended applications are the rule, not the exception. On the basis of

the estoppel rules applied in the courts up until 1996, it was very common for applicants to make voluntary amendments with little or no explanation on the written record. In the case of these previously issued patents still in effect, there is little that a patentee can now do to overcome the burden created by Festo and avoid any finding of prosecution history estoppel. In many cases where patentees previously might have disputed whether prosecution history estoppel applied, the existence of estoppel is now a foregone conclusion, and the battleground issue is, "What is the boundary of the element that is subject to the estoppel, for which equivalence is barred? "The court did not explain whether the amended element refers only to the specific words added to a claim or to the whole clause in which the word is added. It appears that patentees still have room to argue that the subject matter surrendered consists only of the specific words added to the claim. For example, if a clause of an original claim requires "a microcomputer having a display and a keyboard," and the amended clause requires "a microcomputer having a display, a keyboard, and a pointing device," the patentee can argue that the element surrendered is a system without a pointing device. In other words, the patentee can argue that equivalents may be substituted for the microcomputer, the display or the keyboard, so long as the pointing device is literally present. (Of course, the accused infringer will most certainly argue that the doctrine is completely barred with respect to the microcomputer, the display, the keyboard and the pointing device and that the patent does not cover a system in which an equivalent is substituted for any of these devices.) Another remaining battleground issue is whether narrower original claims that were never amended or argued are eligible for the doctrine of equivalents after issuance, if broader original claims were rejected or canceled during prosecution. Festo does not give a clear indication on this question. A similar question remains unanswered with respect to narrower original claims that the examiner found

to contain allowable subject matter, and were only amended as to matters of form. It is not clear whether the existence of broader original claims that were rejected or canceled during prosecution would preclude doctrine of equivalents for the issued narrower claims. Until these issues are decided, patentees should argue for the continuing availability of the doctrine in these circumstances (and accused infringers should argue that estoppel is present, barring application of the doctrine). In view of the Festo decision, most patentees will probably be more reluctant than ever to enforce their patents, where infringement only lies under the doctrine of equivalents. If that occurs, the Federal Circuit's goal of increasing predictability and clearer guidance through the notice function of claims will have been achieved. The Festo decision will also change the way in which patent rights are procured. For any invention for which a patent may potentially be enforced in court, there is little alternative but to vigorously traverse any arguably improper rejection, and appeal any adverse decision of the examiner where there is a reasonable likelihood of reversal. Extra time spent studying the prior art before drafting the patent application is well spent, enabling the patent drafter to craft claims of the proper scope and minimizing the necessity for amendments that lead to prosecution history estoppel. Unfortunately, this will increase the initial costs of the patent application for inventors. Also, there is no guarantee that the examiner will recognize the distinguishing features of even the most carefully crafted claim. An improper rejection by the examiner will require the applicant to file explanatory arguments, creating the same prosecution history estoppel the drafter seeks to avoid. For any allowed (ready for issue) patent application that is potentially important enough to be enforced, the prosecuting attorney should ensure that a continuing application is filed before the allowed application issues as a patent. Until the activities of a potential infringer are precisely identified, it is impossible to know whether any

of the issued claims provide exactly the right coverage needed to succeed in an infringement action without relying on the doctrine of equivalents. By keeping a continuing application pending, the patentee is positioned to add or amend claims to obtain exactly the coverage required to make a showing of literal infringement, and avoid disputes over equivalence. The patent regulations allow the applicant to petition to advance the examination of the application when an infringer has already been identified, so the continuing application can be expedited. A concurring opinion in Festo suggests that patent drafters may now begin claiming inventions narrowly, to obtain immediate allowances (avoiding prosecution history estoppel), and actually rely more heavily on the doctrine of equivalents during litigation. Given the likelihood that the Federal Circuit will continue its antipathy towards finding infringement under the doctrine of equivalents, adoption of this strategy appears to be ill-advised.

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APPENDIX D

Professor Kayton's April 2001 Program
The Westin Innisbrook Resort
TRIANGULATED BY TAMPA BAY, CLEARWATER BEACH,
AND TARPON SPRINGS, FLORIDA
FINAL REMINDER

April 22 – 24 Sunday, Monday & Tuesday
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8 a.m. – 12:15 p.m., Saturday

Projected State Bar CLE Credit: 15 Hours (Including 1.5 Hours Legal Ethics)

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Los Angeles, California
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Timothy W. Hagan

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Dayton, Ohio
(former Technical Adviser to the late Circuit Judge Miller)

Richard L. Rainey
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP,
Atlanta, Georgia
(former Technical Adviser to Circuit Judge Rader)

COURSE DESCRIPTION

The patent bar, more than ever before, must be or become expert in the nuances, variations, inconsistencies, and virtually daily new developments of the U.S. Court of Appeals for the Federal Circuit. In no other way can a patent practitioner serve his or her clients effectively and practice with a modicum of peace of mind.

After many years of genuinely building a foundation of doctrinal stability in the law of §102 and §103, the Federal Circuit's law relative to invalidity under §112, para. 1, literal infringement, the doctrine of equivalents, and §112, para. 6 claim construction, has fallen into a state of disarray comparable to that which characterized the regional Circuit Courts of Appeals prior to 1982.

The Federal Circuit's various panels' lack of coherent doctrinal stability has permeated many regions of patent law seemingly randomly. Consider, below, some of the surprising and diverse 717 Madison Place, N.W., developments of the past two years.

- *Eli Lilly v. Barr Laboratories* held that a claim to a chemical species (Prozac®) is invalid for obviousness type double patenting over the previously patented generic claim, even though the panel refused to even consider the record-laden evidence that the Prozac® species would have been

unobvious to a person of ordinary skill relative to the dominant generic claim. According to Circuit Judge Gajarsa, it is "of no consequence" what such a person considers nonobvious; he thereby rendered invalid every commonly-owned *patentable* species invented and patented after a generic claim issues. Rehearing of this incredible, bombshell decision is being sought by *Eli Lilly* and five distinguished *amici*.

- Over a vigorous, compelling dissent by Circuit Judge Newman, *PerSeptive Biosystems v. Pharmacia Biotech* held that claims were inequitably procured for failure to name as inventors two people who where *not* coinventors of those claims, but who arguably may have contributed to claims that had been cancelled, thereby writing out of 37 CFR §1.56 the tenet that cancelled claims cannot be the basis for a holding of inequitable conduct.

- Can a 47.8% length in an accused structure be the equivalent of slightly more than 50% length when the claim calls for a "majority" length? No, according to *Moore U.S.A. v. Standard Register* as a matter of *claim construction* despite the dissents' cogent observation that "whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law."

- In a case of first impression, information was properly added to a patent's specification by way of a Certificate of Correction which resulted in a claim being properly supported by the specification. That claim, however, was held invalid during the period *prior* to the Certificate's issuance because 35 USC §254 was interpreted by the Federal Circuit to mean that the Certificate validated the patent only for "actions for causes arising *after* the PTO issues a certificate of correction."

- Troubling to many of the patent bar has been the

Federal Circuit's massive resort to issuing non-precedential opinions. Admittedly, the court's workload is daunting. But the consequence is that it is no longer possible to discern fully the trends of patent law change solely from the court's published opinions. **Approximately 60% of the court's patent decisions now come down in "unpublished," non-precedential slip opinions. But major, new directions in patent law have been charted in many of those non-precedential opinions of which the typical practitioner is unaware because the opinions are only occasionally published in the USPQ**. Those cases represent the firmly held views of many members of the court, and should be treated as the law in actual, daily practice. Yet, they must never be cited under Federal Circuit rules (which are rigidly enforced).

This course openly treats non-precedential opinions as of *de facto* importance in learning how properly and effectively to practice patent law on a daily basis (but our texts and lectures boldly flag them as non-precedential).

One important aspect of this course is the presentation and explanation of background cases by the faculty so that the many new, current Federal Circuit cases can be fully appreciated.

As part of your *ex parte* and *inter partes* empowerment process at this course, you will also learn about all the genuinely fascinating new, non-chaotic law that has emanated during the past three years from the Federal Circuit in the many areas set forth in the syllabus below.

COURSE SYLLABUS

Claim Construction
Doctrine of Equivalents
Substantive Interference Law
Design Patents

Prosecution History Estoppel
URAA Term Extension Provisions
Literal, Induced & Contributory Infringement
Novelty and §102
Obviousness/Nonobviousness
35 USC §112 Issues
35 USC §101 Issues
Removing Prior Art References
Correction of Patents Including Reissue and Reexamination
Double Patenting
Inventorship
Legal Ethics In Patent Law – Inequitable Conduct (*will be presented on the second day from 3:00 to 4:30 p.m.*)
License and Assignment Issues
Relief Available to the Prevailing Patent Litigant

COURSE MATERIALS

The full substance of the course is captured in the Year 2001 edition of the two-volume text which extends over 800 pages. The volumes will be sent to attendees in advance of the course.

* * *

APPENDIX E

PATENT, TRADEMARK & COPYRIGHT JOURNAL

September 29, 2000

Range of Equivalents for 'Majority' Does Not Encompass 'Minority'

A range of equivalents for the claim limitation "majority of the length" that encompasses "minority of the length" would improperly vitiate the claim limitation, the U.S. Court of Appeals for the Federal Circuit held Sept. 22 (*Moore U.S.A. Inc. v. Standard Register Co.*, Fed. Cir., No. 98-1386, 9/22/00).

Affirming a summary judgment that three patents on two-way mailers were not infringed, the court noted that all claim limitations are not entitled to an equal scope of equivalents. In addition, the court found no support for arguments that copying with knowledge of the patent creates a greater range of equivalents and that equivalents infringement may be established by the rearrangement of claim limitations. Judge Pauline Newman concurred in part and dissented in part, arguing that the majority decision resolved issues of fact.

Non-Infringement Ruling. Moore U.S.A. Inc. holds three patents (5,201,464, 5,253,798, and 5,314,110) on two-way mailers.

The '464 patent discloses a C-fold mailer-type business form with an integral return envelope that is created during the folding and sealing process. The '798 patent covers a mailer-type business form with a pressure seal adhesive pattern that avoids interference with the printer rollers during

printing. The '110 patent relates to another mailer-type business form that is double-folded to provide four panels for information to be printed on the mailer.

Moore sued Standard Register Co. (SRC), arguing that Moore's patents are infringed by SRC's Form 8120C04 C-fold mailer with an integral return envelope, its continuous web, Z-fold mailer with three panels separated by fold lines, and its form with ten widely-spaced circular patches of adhesive.

Senior Judge Albert V. Bryan Jr. of the U.S. District Court for the Eastern District of Virginia issued a summary judgment of non-infringement as to all three patents, and Moore appealed.

C-Fold Mailer. The '464 patent claims adhesive strips which extend a "majority" of the lengths of the longitudinal margins of the patented form. Moore contended that the district court improperly refused to construe the range of equivalents for this limitations to cover SRC's longitudinal adhesive strips extending along a "minority" of the lengths of the longitudinal margins.

The Federal Circuit disagreed, pointing out that the case law makes clear that all claim limitations are not entitled to an equal scope of equivalents. Judge Paul Michel pointed to the "all limitations rule" under *Pennwalt Corp. v. Durand-Wayland Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987) (35 PTCJ 23, 11/12/87), prosecution history estoppel under *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997) (53 PTCJ 369, 381, 3/6/97), and the inherent narrowness of the claim language under *Sage Products Inc. v. Devon Ind. Inc.*, 126 F.3d 1420, 44 USPQ2d 1103 (Fed. Cir. 1997) (54 PTCJ 434, 9/25/97).

Invoking the all limitations rule, Judge Michel observed

that allowing what is undisputedly a minority length to be equivalent to a majority length would vitiate the requirement that the adhesive strips "extend the majority of the lengths" of the margins. In addition, "it would defy logic to conclude that a minority—the very antithesis of a majority—could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise," he wrote.

The court also rejected Moore's contention that SRC's knowledge of the patents and its copying entitles the patent to a broader scope of equivalents. Although Moore's argument relied on *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 85 USPQ 328 (1950), the Federal Circuit found nothing in that opinion to support Moore's view. In fact, Judge Michel maintained, the Supreme Court's opinion in *Warner-Jenkinson* implies the exact opposite by rejecting the relevance of an accused infringer's intent upon the doctrine of equivalents.

Finally, the appellate court rejected Moore's argument that the written descriptions's teaching that the adhesive strips may be about "half of the length" of the margins supports a scope of equivalents covering a "minority." Judge Michel explained as follows:

> In *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996), we explained the contrary principle that "subject matter disclosed in the specification, but not claimed, is dedicated to the public" in determining infringement under the doctrine of equivalents. *Id.* at 1107, 39 USPQ2d at 1007. Having fully disclosed two distinct embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, Moore is not entitled to "enforce the

> unclaimed embodiment as an equivalent of the one that was claimed." *YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320, 46 USPQ2d 1843, 1845 (Fed. Cir. 1998).

The appellate court accordingly upheld the district court's summary judgment of no infringement by equivalents for Claim 1 of the '464 patent.

Moore also argued that the SRC form is functionally identical to other claim elements of the '464 patent. The SRC form is merely a "rearrangement of claim limitations" which can be covered as an infringing equivalent, according to Moore, citing *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929).

The court rejected the argument. While the *Sanitary Refrigerator* clearly refers to reciprocal changes from the form of the patent structure, it nowhere authorizes the rearrangement of claim limitations, Judge Michel wrote. The case presents a typical doctrine of equivalents scenario, and does not conflict with the holding in *Sage* that the public has a right to rely on clear structural limitations contained in a patent, according to the court.

Printer Mailer. The '798 patent is entitled "Pressure Seal Adhesive Pattern for IBM 3800 Printers," and Claim 1 provides for the adhesive to be spaced from the transverse edge by "a distance sufficient" to avoid interfering with the printer rollers. Moore argued that the district court erroneously construed the "distance sufficient" term as constrained by the particular specifications of the IBM 3800 printer.

The Federal Circuit agreed, noting that the plain language of Claim 1 recites a "printer" generally, and nowhere mentions the IBM 3800 printer. While the written

description refers repeatedly to the IBM 3800 printer, Judge Michel conceded, it clarifies that a form for use on an IBM 3800 printer is only the preferred embodiment. That the title refers to an IBM 3800 printer does not change the analysis, he added, reasoning that the bar on importing limitations from the written description into the claims also applies to a title. This interpretation is also supported by the prosecution history, according to the court.

However, the court found this claim construction error "entirely harmless" and rejected Moore's contention that it requires that the summary judgment of noninfringement be vacated. Noting that the patentee must prove infringement, the court pointed out that Moore provided no evidence that SRC's use of any printer other than the IBM 3800 would have satisfied the "distance sufficient" limitation. Nor does Moore dispute that the adhesive on SRC products cannot avoid interference with printer rollers, Judge Michel added.

Double-Fold Mailer. Claims 1 and 11 of the '110 patent require that the sheet of paper be "devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness." Moore argued that the district court improperly construed the term "devoid of adhesive" in view of the prior art and prosecution history. It maintained that the term encompasses a form with "no adhesive extending *substantially completely* along *both the end edges* between the lines of weakness," as in the prior art Conti patent.

The appellate court disagreed, noting that the Conti patent discloses an intermittent strip of non-permanent adhesive along the transverse end edge of one face. Because the adhesive strip in Conti can be intermittent, the Federal Circuit explained, we are perplexed by Moore's reliance on the prior art as somehow supporting a construction of "adhesive" as limited to a substantially complete strip.

In view of its rejection of Moore's arguments with regard to "substantially completely" and "end edges" and "along," the Federal Circuit held that the SRC form cannot literally satisfy the "devoid of adhesive" limitation of Claims 1 and 11. The summary judgment of no literal or equivalents infringement of the '110 patent was affirmed.

Dissenting and Concurring Opinion. Judge Newman concurred in the non-infringement judgment for the '798 patent, the '110 patent, and Claim 1 of the '464 patent. However, she objected to the court's reasoning with respect to the '798 and '464 patents. For Claim 9 and related claims of the '464 patent, she would have reversed and remanded. (Ed. Note: Judge Newman filed a corrected version of her opinion on Sept. 27, 2000.)

As to the '798 patent, Judge Newman faulted the majority for rejecting the district court's claim construction, and then "mysteriously interpret[ing] the claims the identical way as did the district court, that is, limited to the IBM 3800 printer and the adhesive distances described in the specification." "Extensive precedent requires that claims be construed the same way for all purposes," she insisted, dissenting from the majority's "novel ruling."

Judge Newman also took issue with the majority's ruling that the adhesive strips in the accused SRC form were not an infringing equivalent of the "first and second longitudinal adhesive strips" claimed in the '464 patent. She pointed specifically to the court's holding that 47.8 percent cannot be equivalent to 50+ percent claimed as the "majority of lengths" of the form. "Whether 47.8% is equivalent to a majority is a question of fact, and could not be decided adversely to the patentee as a matter of law," Judge Newman wrote.

Finally, Judge Newman disagreed with the majority's

ruling that the doctrine of equivalents cannot be invoked to reach rearranged claim elements. "[P]recedent contravenes such an automatic bar," she insisted, citing *Warner-Jenkinson, Sanitary Refrigerator*, and *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989) (37 PTCJ 421, 3/2/89).

PTCJ COMMENT: This opinion provides another occasion for lawyers to complain about conflicting Federal Circuit case law. The problem is the statement "subject matter disclosed in the specification, but not claimed, is dedicated to the public," made by Judge Alan Lourie in *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996) (52 PTCJ 198, 6/13/96). In the non-precedential *Brunswick Corp. v. U.S.*, 46 USPQ2d 1446 (Fed. Cir. 1998) (55 PTCJ 562, 4/9/98), Judge Raymond Clevenger denied that the court's application of *Maxwell* was inconsistent with *Warner-Jenkinson*, and Judge Newman dissented. In *YBM Magnex, Inc. v. International Trade Comm'n*, 145 F.3d 1317, 1320, 46 USPQ2d 1843, 1845 (Fed. Cir. 1998) (56 PTCJ 134, 6/4/98), Judge Newman attempts to distinguish away the statement in *Maxwell* as limited to the facts of that case. Finally, this case repeats the *Maxwell* maxim. To make matters worse, Judge Michel surprisingly cites *YBM* as supporting authority and quotes a passage from that case which was intended to do no more than describe the *Maxwell* holding. In a recent speech, Judge Lourie tried to explain that this type of situation does not represent conflicting Federal Circuit law, but rather conflicting responses to appellants' arguments (60 PTCJ 138, 147, 6/16/00). He also critiqued appellants for careless citation of loose language from other opinions to support an argument. "Reckless citation of non-controlling language just suggests the weakness of your case," he stated.

Full text at http://pub.bna.com/ptcj/981386.htm